

REMARKS

Claims 30 and 33 have been amended to correct a grammatical error.

In ¶ 4 of the Office Action, claims 29-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,449,001 to Levy *et al.* in view of U.S. Patent No. 5,791,907 to Ramshaw *et al.* and further in view of U.S. Patent No. 6,477,708 to Sawa. The Applicants traverse this ground of rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, as set forth at MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the combined prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Applicants apply these criteria below to show that the Examiner has failed to establish a *prima facie* case of obviousness. Thus, the rejection based on Levy, Ramshaw and Sawa should be withdrawn.

In the first place, the third criterion has not been met in the office action. It is well settled that "[a]ll words in a

claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03 further states: "When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, ...". Each of independent claims 29, 30 and 33 contains the limitation that each of the training videos shows one or more of the following:

how to operate a medical diagnostic imaging system of said respective imaging modality, how to perform an examination of a particular exam type on a patient using a medical diagnostic imaging system of said respective imaging modality or how to make a diagnosis during an examination of said particular exam type performed using a medical diagnostic imaging system of said respective imaging modality

In the Office Action, Ramshaw is cited for teaching "the use of a video segment to train with respect to a medical procedure". More particularly, Ramshaw teaches the use of videos for training in surgical procedures. Ramshaw is silent concerning videos for training in how to operate a medical diagnostic imaging system, how to perform an examination using such equipment, or how to make a diagnosis during such an examination. Nor do Levy or Sawa disclose these limitations.

Furthermore, each of claims 29, 30 and 33 recites that, in substance, that both the training video and a diagnostic image of a portion of the anatomy of a patient acquired during an examination are viewed on the same display monitor. This limitation is also absent from each of the Levy, Ramshaw and Sawa references. Ramshaw and Sawa say nothing about imaging of a patient's anatomy for the purpose of diagnosis. To the extent

that Levy mentions imaging equipment [see, e.g., col. 2, line 13], diagnostic imaging would be performed on that imaging equipment, not on the portable computer that is connected to such imaging equipment for teleconferencing purposes. In other words, to the extent that Levy teaches the use of a training video, such video is viewed on the portable computer, whereas the diagnostic image would be viewed on the imaging equipment, i.e., different display monitors would be used.

Since none of the three cited references discloses either training videos of the type recited in independent claims 29, 30 and 33 or that the training video and diagnostic images are viewed on the same display monitor, the Applicants respectfully submit that a *prima facie* case for obviousness has not been made.

Also, no motivation for combining the teachings of Levy and Ramshaw can be found in either reference. The Levy patent discloses a teleconferencing system in which the video communications between two locations are bidirectional. The video communications are between the host site and a portable computer at the remote site. In the rejection, the Examiner treats the portable computer as being part of a medical diagnostic imaging system. The crux of Levy's invention is the provision of a portable computer that can be used to provide diagnostic services for servicing any medical apparatus at any remote site. As stated in column 3, lines 10-13: "Preferably, the remote site assembly is portable to enable setup of the of

the assembly in proximity to the device or process that is the subject of the conferencing session." More specifically, Levy discloses that the laptop or notebook computer can be moved from one medical apparatus to another at the same remote site, and can be carried to different remote sites. Levy only discloses that the telecommunication link between computers at the host and remote sites is used "to provide diagnostic services for servicing various research devices, medical equipment and related processes" [see Levy, col. 1, lines 21, 22]. Examples of areas in which the Levy system can be used include:

diagnosing instrument malfunctions, determining misalignment and movement impairments for robotics applications, monitoring fluidic action in medical applications, diagnosing pressure or vacuum malfunctions and mechanical impairments, diagnosing and adjusting electronic circuitry, and diagnosing technical malfunctions of chemical reactions and dilution ratios

[see Levy, col. 1, lines 57-64].

In contrast to the Levy system, which is intended for use in diagnosing equipment problems, Ramshaw teaches the provision of videos for training in surgical procedures. The performance of surgery presumes that the operating equipment is not malfunctioning. Accordingly, one kind find no motivation or suggestion for the concept of making training videos for surgical procedures available on a portable computer intended for use in troubleshooting and diagnosing equipment malfunctions.

Accordingly, the Applicants respectfully submit that a *prima facie* case for obviousness has not been made and the

obviousness rejection based on Levy, Ramshaw and Sawa should be withdrawn.

In view of the foregoing, the Applicants submit that this application is now in condition for allowance. Reconsideration of the application and allowance of claims 29-33 are hereby requested.

Respectfully submitted,

June 13, 2006

Date



Dennis M. Flaherty

Reg. No. 31,159

Ostrager Chong Flaherty &
Broitman P.C.

250 Park Avenue, Suite 825

New York, NY 10177-0899

Tel. No.: 212-681-0600

CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

June 13, 2006



Dennis M. Flaherty